

REMARKS

The Amendments

Claims 1 and 2 are amended to exclude 2,5-dimethyl-3-thienyl as an option for R¹.

Claims 5-7 and 11 are amended to correct an obvious claim dependency error. Support for new claims 18 and 19 is found in the specification at page 4, lines 24-26, and page 6, lines 4-5, for example.

Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

The Rejection under 35 U.S.C. §102

The rejection of claims 1, 16 and 17 under 35 U.S.C. §102, as being anticipated by Jakobsen (CAPLUS), is respectfully traversed. The Jakobsen abstract is derived from EP App. Pub. No. 571685 A1, a copy of which is attached to this reply. References to Jakobsen below are to this full publication.

Jakobsen discloses the compound 3-butylamino-1-(2,5-dimethyl-3-thienyl)propanone in Example 1, page 7. This is the compound shown at the bottom of the Abstract. The compound is disclosed as an initial starting material in the multi-step method of Jakobsen's Example 1 for preparing the aryloxyheteroarylpropylamine compounds of formula (I) which are the primary subject of Jakobsen's invention.

The claims have been amended to exclude this compound disclosed by Jakobsen. This is the only propanone compound which is disclosed by Jakobsen. Thus, the claims excluding the

Jakobsen compound are not anticipated by Jakobsen and the rejection under 35 U.S.C. §102 should be withdrawn.

Further, the compounds as currently claimed would not be obvious to one of ordinary skill in the art from Jakobsen. Jakobsen discloses 3-butylamino-1-(2,5-dimethyl-3-thienyl)propanone only as an early intermediate in one of several possible synthesis methods for its final compounds. No motivation exists to modify such a compound, which is taught only as an intermediate, to arrive at compounds having a utility other than as an intermediate; see, e.g., In re Lalu, 74 F.2d 703, 223 USPQ 1257 (Fed. Cir. 1984); and MPEP §2144.09(VI), citing Lalu.

The Withdrawn Method Claims

Applicants respectfully submit that the withdrawn method of preparation claims, claims 2-11, should be rejoined with the compound claims – which in light of the above are believed to be allowable. If the compounds are novel and nonobvious, it logically follows that the method for making those compounds would be novel and nonobvious, i.e., if the compounds are not known or suggested, there is no motivation to provide a method for making them. Rejoinder of such claims is in accordance with the practice in In re Ochiai, 37 USPQ2d 1127 (Fed. Cir. 1995), In re Brouwer, 37 USPQ2d 1663 (Fed. Cir. 1996), and the Commissioner's notice thereon at 1184 TMOG 86, March 26, 1996.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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